

REMARKS

Reconsideration of the subject application is respectfully requested in light of the comments which follow. Claims 4, 6 and 9-20 are pending.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

Claims 4, 9-13 and 15-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,507,551 to Howard et al. (hereafter "*Howard et al.*") in view of Applicant's Admitted Prior Art, U.S. Patent No. 5,369,511 to Amos (hereafter "*Amos*") and U.S. Patent Application Publication No. 2001/0029816 to Ben-Menachem et al. (hereafter "*Ben-Menachem et al.*") on the grounds set forth in paragraph 3 of the Official Action. For at least the reasons noted below, this rejection should be withdrawn.

First, the Official Action in the comments on Applicant's previous arguments, appears to focus on the alleged similar result between the combination of cited references and Applicant's claims. However, lost in the discussion of results in the Official Action is any indication on the structural features and/or arrangement of features that may properly form the basis of an obviousness rejection.

In other words, Applicant's claimed specific structural features and arrangements, e.g., the first aspheric, the second aspheric, and the holographic optical element, to obtain the desired result. Whereas, in contrast, the cited references, even if they result when in combination in the same result as Applicant, do not contain the structural features of Applicant's claim. In such case, the cited documents would merely show that there is more than one way to solve a problem – the Applicant's claims and the proposed combination. But such dual paths would not

preclude patentability of each separate path because the features and arrangements would be distinct.

Further, it is respectfully asserted that the analysis by the Examiner is flawed. *Howard et al.* (the base reference) is acknowledged as lacking the explicit description of the first aspheric profile on a first side and a second aspheric profile on the second side and having a holographic optical element (see page 3 of the Official Action) and having the operability at the claimed wavelengths. The Official Action merely relies on an optimization based on alleged admitted prior art and the disclosure in *Ben-Menachem et al.* and *Amos* to provide the necessary motivation and teachings to arrange features not present in *Howard et al.* alone. However, such optimization of variables without any evidence or rationale as to obtaining the claimed infrared imaging apparatus is unpersuasive, particularly in view of the silence within the references as to the claimed correction of a first color band and a second color band.

Therefore, it is respectfully asserted that it is simply not known from the references cited by the Examiner whether Applicant's claimed infrared imaging apparatus could result from optimization based on the teachings and disclosures in the cited references. By way of example, it is not known whether the addition of any of the features from Applicants' alleged admitted prior art, *Ben-Menachem et al.*, and/or *Amos* would adversely impact the *Howard et al.* teachings such that optimization would in fact lead away from Applicant's claimed infrared imaging apparatus. Indeed such optimization based on the collective teachings could readily result in a completely different apparatus, for example, one that did not have aspheric profiles on first and second sides of a common first lens, but rather uses

multiple lenses or placed additional optical features from these references to solve similar or different problems.

Thus, in summary, it is respectfully asserted that the Examiner's rejection is based merely upon conjecture, speculation or assumptions and does not form the proper basis for an obviousness rejection. Indeed, it is well settled that a rejection based on 35 U.S.C. §103 must rest upon factual basis rather than conjecture, speculation, or assumptions. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967).

Moreover, while it is generally true that omission of an element with retention of the element's function is an indicia of unobviousness, a corollary from such a maxim could well read "obtaining an element's function through the use of different elements is also an indicia of unobviousness," cf., *In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966). Here, an application of the principles in *In re Edge* would find that different structural arrangements of infrared imaging apparatus components although resulting in a similar function to a reference or combination of references of different components, does not preclude patentability as it is not obvious to use the specified claimed components and arrangements of components in view of the different arrangement in the cited references.

Based on the above, it is respectfully requested that the rejection of Applicant's claims based on 35 U.S.C. §103 be reconsidered and withdrawn.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

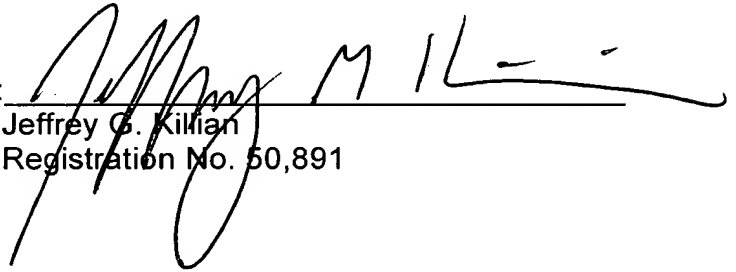
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By: _____

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A handwritten signature in black ink, appearing to read 'Jeffrey G. Killian', is written over a horizontal line. The signature is stylized with large, flowing loops.